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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,371	04/08/2004	Thomas V. Wilder	DAREDEV.63DV1C1	7630

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EXAMINER

MORAN, KATHERINE M

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tate

Office Action Summary	Application No. 10/820,371	Applicant(s) WILDER ET AL.	
	Examiner Katherine M. Moran	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-13,16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

Applicant's response of 6/17/05 has been received and reviewed. Applicant amended claim 1 to overcome a previously cited claim objection, added new claims 17-20, and submitted a replacement drawings sheet for Figures 3 and 4. Claims 1-5, 8-13, and 16-20 are pending.

Claim Objections

1. Claim 17 is objected to because of the following informalities: line 2: delete "font" and insert --four--. (This was assumed to be the proper correction-please advise). Appropriate correction is required.

Drawings

2. The drawings were received on 6/17/05. These drawings are acceptable.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. Claim 18 recites in part that only the thumb-receiving portion comprises a plurality of hinged rigid shell portions and none of the remaining finger sheaths includes a plurality of hinged rigid shell portions. However, Applicant's disclosure has not explicitly excluded other embodiments. Omission of a particular embodiment from the specification and drawings does not necessarily serve as an explicit exclusion of, or as antecedent for, that particular embodiment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gambee (U.S. 1,951,190). Gambee discloses the invention as claimed. Gambee teaches a glove, which could be worn while playing hockey, for enclosing a human wrist and hand, the hand including a dorsal side, a palm side, four fingers and one thumb having a dorsal side, an inner side, middle phalanx, a distal phalanx, and an articulation between the middle and distal phalanxes, the glove comprising a cuff portion 26 surrounding the wrist, a hand-receiving portion having a thumb-receiving portion 11 receiving the thumb of the hand, the thumb-receiving portion having a rigid thumb shell covering at least in part the dorsal side of the thumb, the rigid thumb shell having first and second shell portions 28,29 that partially overlap one another at 28a,29a, a first

movable joint at 25 or at the opposing end of portion 23a at the distal end of portion 29, between the cuff portion and first shell portion, and a second movable joint 30 between the first and second shell sections. The first and second shell portions 28,29 are hinged together at 30 near the articulation between middle and distal phalanxes. The stopping means is defined by the overlapping portions 28a,29a in that the underlying portion 29a prevents further rotation by portion 28a. A degree of overlap between the first and second shell portions inherently varies when one of the first and second shell portions is hingedly moved relative to the other of the first and second shell portions in that depending upon the angle of rotation, a greater surface area of the shell portion is covered or overlapped by portion 28a.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5, 8-13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thurston et al. (Thurston, U.S. 4,272,849) in view of Sauriol (U.S. 5,946,720). Thurston discloses the invention substantially as claimed. Thurston teaches a protective glove 10, which could be worn while playing hockey, for enclosing a human wrist and hand, the glove including a hand-receiving portion 11 comprising a palm side 15 facing the palm side of a hand, a dorsal side 14 facing the dorsal side of

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the hand, finger sheaths receiving the four fingers of the hand, and a thumb-receiving portion receiving the thumb of the hand, the thumb-receiving portion having a rigid thumb shell covering at least in part the dorsal side of the thumb, with one embodiment describing the thumb shell as having first and second shell portions 31,33 that partially overlap one another (Figures 6 and 7). The glove also includes a cuff portion surrounding the wrist. The first shell portion covering at least partially the middle phalanx of the thumb and the second shell portion covering at least partially the distal phalanx of the thumb, the first shell portion being hinged to the second shell portion by hinge 32. The glove further includes an inner liner 13 formed from cotton or soft wool. The drawings illustrate that the shell portions are hinged together near the articulation between the middle and distal phalanxes and comprise stopping means (in the form of tab 33) for preventing movement of the second shell portion beyond a predetermined point. A degree of overlap between the first and second shell portions inherently varies when one of the first and second shell portions is hingedly moved relative to the other, in that depending upon the angle of rotation, a greater surface area of the shell portion is covered or overlapped by portion 33. When the first and second shell portions are overlapped, the first shell portion extends underneath the second shell portion (Figure 6). With regard to claim 9, Thurston teaches a movable joint between the cuff portion and the first shell portion in that the thumb and cuff portions flex and move in relation to each other. However, Thurston doesn't teach a dorsal side of the hand-receiving portion having a padded surface, and a cuff portion having a plurality of padded elements positioned around at least a portion of the circumference of the cuff portion, with each

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padded element partially overlapping an adjacent padded element. Sauriol teaches a protective glove with a padded dorsal side 14 and a cuff portion 22 having a plurality of padded elements 36,40 in an overlapping relationship. The pads allow for maximum flexibility of the wrist while the padded portion provides additional protection to the vulnerable dorsal area. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Thurston's glove with a padded back and cuff, as taught by Sauriol, in order to reinforce the glove's protective properties while preserving the glove's flexibility.

Allowable Subject Matter

4. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 18-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed 6/17/05 have been fully considered but they are not persuasive. Applicant argues that Gambee does not meet the recited limitations of claims 9-13. Applicant points out that Gambee's device is intended to be used in fine, precise work and intentionally leaves most of the hand exposed, and as a result,

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teaches against enclosing the wearer's hand. The Examiner respectfully disagrees.

Note that the preamble of claim 9 recites in part "A hockey glove for enclosing a human wrist and hand...." . Note also that Gambee's device does in fact enclose a human wrist and hand to some degree. As held by the Court of Appeals Federal Circuit, "A claim preamble is limiting if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim. However, if the body of the claim describes a structurally complete invention such that the deletion of the preamble phrase does not affect the structure or steps of the claimed invention, then the preamble is generally not limiting." The structural components of the glove are outlined in the body of claim 9 as a structurally complete invention as follows:

- A cuff portion surrounding the wrist
- A hand-receiving portion having a thumb-receiving portion receiving the thumb of the hand, *the thumb-receiving portion having a rigid thumb shell covering at least in part the dorsal side of the thumb*, said rigid thumb shell having first and second shell portions that partially overlap one another
- A first movable joint between said cuff portion and said first shell portion; and
- A second movable joint between said first and second shell portions

Applicant further notes that Gambee fails to teach enclosing a human wrist and hand, a glove having both a dorsal side and a palm side, a cuff portion, or a hand-receiving portion. In response, please note that Gambee's device encloses the wrist and hand as shown most clearly in Figures 1 and 6, includes a cuff portion 26, a hand receiving portion 35 or 10-15, and both a dorsal side and a palm side (represented by the palm

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side of cuff 26, the lower portions of curved sides 31, and portions 10-15). Also, in response to applicant's argument that the Gambee reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (a glove having a palm side) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). With respect to the italicized text above, note that the thumb-receiving portion is defined as covering at least in part the dorsal side of the thumb. Thus, no part of claim 9 recites the hockey glove of the present invention as including a palm side.

Accordingly, Gambee meets the claimed limitations of claims 9-13.

Applicant also has presented arguments with respect to the prior art rejections over Thurston in view of Sauriol. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

Applicant argues that Sauriol teaches against combination with the teachings of Thurston in that the gloves are directed towards different uses, environments of use, and values. Thurston has been combined with Sauriol in order to modify Thurston to provide a padded cuff portion at the wrist, with the padded elements positioned around

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at least a portion of the circumference of the cuff portion, with each padded element partially overlapping an adjacent padded element. Applicant further points out that the bulkiness of Sauriol's glove teaches against its suitability to be combined with Thurston. The only structural feature gleaned from Sauriol is the padded cuff. Thurston's glove structure is designed to protect the wearer's hand from impact. A padded cuff would easily lend itself to this structural design. Sauriol teaches that it is desirable to provide a glove with a padded cuff, wherein the cuff elements overlap each other, in order to protect the wrist/forearm portion and allow for full flexibility of the wearer's wrist.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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September 7, 2005

A handwritten signature in black ink, appearing to read "K Moran", with a stylized, cursive script.

Katherine Moran

Primary Examiner, AU 3765